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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,136	11/07/2001	Byung Hee Sohn	263/009	4660

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LEE & STERBA, P.C.
1101 WILSON BOULEVARD
SUITE 2000
ARLINGTON, VA 22209

EXAMINER

GARRETT, DAWN L

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,136

Applicant(s)

SOHN ET AL.

Examiner

Dawn Garrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5, 11-13 and 18 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-10 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment, paper no. 9, dated June 27, 2003. Claims 1, 6, 7, and 17 were amended. Claim 17 is withdrawn as non-elected. Claims 1-18 are pending and claims 1-16 and 18 are currently under consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The objection to the oath set forth in paper no. 8, paragraph 3, mailed March 27, 2003, is withdrawn due to the substitute oath, paper no. 10.
4. Claims 1, 2, 6-10, and 14-16 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The variable "n" in the formulas of claims 1 and 6 has not been defined and accordingly, it is unclear how many repeating units in parenthesis may be present in the polymer. For the purpose of examination, "n" has been interpreted as an integer of one or greater. Clarification and correction are required.
5. The rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Journal of the Korean Physical Society, 37(1), 59-63, 2000 is withdrawn due to the amendment of claim 1.
6. The rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Chemical Materials, 2000, 12, pages 1067-1070 is withdrawn due to the amendment of claim 1.

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7. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Synthetic Metals, 102 (1999), pages 961-962 is withdrawn due to the amendment of claim 1.

8. The rejection of claims 1, 2, and 8 under 35 U.S.C. 102(b) as being anticipated by Advanced Materials (Weinheim, Germany), 10(14), 1112-1116, 1998 is withdrawn due to the amendment of claim 1.

9. The rejection of claims 6, 9, 10, 14-16 under 35 U.S.C. 103(a) as being unpatentable over Advanced Materials (Weinheim, Germany), 10(14), pages 1112-1116, in view of Jin et al. (US 6,368,732) is withdrawn due to the amendment of claims 1 and 6.

Claim Rejections - 35 USC § 112

10. Claims 1, 2, 6, 8-10, and 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. (It is noted by the examiner amended claim 17 contains the same new matter as independent claims 1 and 6, but claim 17 is not under consideration at this time as a non-elected claim.) The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitation to claims 1 and 6 "wherein at least one of the X substituents is not a hydrogen" is considered to be new matter. Applicant states support for the limitation may be found in Figure 1 and Examples 1 and 2. The compound of Figure 1 depicts a polymer comprising an -OR group at the X₂ position. The added limitation "wherein at least one of the X substituents is not a hydrogen" is broader than the one compound shown in the

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example. Furthermore, it is seen in the specification where formula (3) would support such an added limitation at page 5, paragraph [0011]; however, it is not seen where formula (I) is described with the same limitation. Accordingly, the examiner concludes the specification does not provide support for the added limitation in claims 1 and 6.

Allowable Subject Matter

11. Claims 3-5, 11-13, and 18 are allowed. Claim 7 contains allowable subject matter, but remains rejected under 35 USC 112, second paragraph, with regard to the indefiniteness of the variable "n". Reasons for allowance and indication of allowable subject matter were provided in the Office action, paper no. 8, mailed March 27, 2003.

Response to Arguments

12. Applicant's arguments with respect to the prior art rejections have been considered but are moot in view of the withdrawal of all the prior art rejections. The 35 USC 112, second paragraph rejection is maintained because applicant did not amend the claims to describe the variable "n" and did not present an argument with regard to this rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (703) 305-0788. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached at (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.


D.G.

September 9, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

